

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	David L. Chalupsky et al.	Examiner:	Brian P. Whipple
Serial No.:	10/656,652	Group Art Unit:	2152
Filed:	September 4, 2003	Docket No.:	P14969
		Confirmation No. :	8297
Title:	METHOD, SYSTEM, AND PROGRAM FOR MANAGING A SPEED AT WHICH DATA IS TRANSMITTED BETWEEN NETWORK ADAPTORS		

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**REPLY BRIEF**

To: Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This Reply Brief is respectfully submitted in response to the Examiner's Answer mailed June 26, 2008. No extension of time fees are believed to be due since the two-month deadline fell on a weekend day.

### **STATUS OF CLAIMS**

Claims 1-52 are pending in the application. Following the final Office Action mailed September 24, 2007, claims 1-2, 4-12, 14-19, 21-24, 26-34, 36, 38-39, 41-42, 44-45, and 47-51 stand rejected under 35 USC §102(e) as being anticipated by Robert et al. (U.S. Publication No. 20040003296; “Robert” hereinafter). Also, claims 3, 13, 20, 25, 35, 37, 40, 43, 46, and 52 stand rejected under 35 USC § 103(a) as being unpatentable over Robert in view of Murase et al. (U.S. Patent No. 6,298,042, “Murase” hereinafter).

Claims 1-52 are being appealed, as detailed in the Appeal Brief filed June 30, 2008. Appellant traverses the rejections. In the interest of brevity, arguments set forth in the Appeal Brief will not be repeated in this document. Nonetheless, these arguments are incorporated herein.

**GROUND FOR REJECTION TO BE REVIEWED ON APPEAL**

I. Whether claims 1-2, 4-12, 14-19, 21-24, 26-34, 36, 38-39, 41-42, 44-45, and 47-51 are anticipated under 35 USC §102(e) by Robert.

II. Whether claims 3, 13, 20, 25, 35, 37, 40, 43, 46, and 52 are obvious under 35 USC § 103(a) over Robert in view of Murase.

## **ARGUMENT**

### *Robert Fails to Disclose or Suggest Limitations Recited in the Claims Rejected*

#### *Under 35 U.S.C. §102(e)*

Claims 1-2, 4-12, 14-19, 21-24, 26-34, 36, 38-39, 41-42, 44-45, and 47-51 stand rejected under 35 U.S.C. §102(e) as being anticipated by Robert. Each of these rejections is respectfully traversed since the cited art fails to teach or suggest the claimed combination of features such as set forth in any of claims 1-2, 4-12, 14-19, 21-24, 26-34, 36, 38-39, 41-42, 44-45, and 47-51.

#### **Claim 1:**

Initially, it is respectfully submitted that the Examiner has failed to establish a prima facie case for anticipation of claim 1. In particular, the final Action fails to establish a prima facie case that Robert anticipates independent claim 1. Anticipation under 35 U.S.C. §102 requires that each and every element of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131).

In the interest of brevity, arguments set forth in the Appeal Brief will not be repeated in this document. Nonetheless, these arguments are incorporated herein.

In Arguments 1, 2, and 3, on pages 12-14 of the Answer, the Examiner argues that all elements of claim 1 are anticipated. However, it is respectfully submitted that this position is simply unsupported and unreasonable.

First, the Examiner has failed to indicate how Robert anticipates the claimed transmission of a new transmission speed.

For example, under Argument 2, the Examiner states:

In response to argument 2, the Examiner discussed in response to argument 1 how the powerdown request of Robert results in a new transmission speed: "in response to a powerdown request ([0023], the powerdown request being analogous to the speed change event of the claim), autonegotiation occurs again in order to utilize a low-power network transmission speed ([0026], lines 1-5)."

Clearly, as stated before, Robert discloses the powerdown request resulting in a low data rate: "For example, Robert discloses that the 'disclosed embodiment enables a workstation to utilize a high-speed data rate for optimum bandwidth during active use, while minimizing power consumption by utilizing a low-power data rate such as 10BaseT during periods of inactivity' ([0027], lines 1-5)."

However, resulting in a new transmission speed fails to anticipate transmission of any transmission speed.

In the discussion above, the Examiner merely appears to indicate that Robert only transmits a "power down request" and not the claimed "new transmission speed." Hence, a case for prima facie rejection has clearly not been made by the Examiner to anticipate these claim elements.

Second, Applicant respectfully disagrees that the link exchange is inherently maintained. In particular, Applicant asserts that the record fails to provide any factual support for a finding of teaching by inherency. To prove inherency, the Examiner must establish that the Robert necessarily includes the limitation regarding transmission "while maintaining a linked exchange between the local and linked network devices" recited in the claims. *Continental Can Co. U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). There is simply no such showing on the record.

For example, under Argument 3 on page 13 of the Answer, the Examiner states:

In response to argument 3, the Examiner notes that in Robert's teachings the autonegotiation and subsequent renegotiation are both between the workstation and a "link partner" ([0019], line 2; [0023], lines 5-6). Therefore, the autonegotiation and renegotiation are themselves linked exchanges of data (in which the workstation and its link partner negotiate a speed). So, the very act of negotiating a transmission speed requires existence of the linked exchange between a local and linked network device, as otherwise the link partners could not communicate in order to set or reset a transmission speed.

However, it is unreasonable to consider that a "link partner" necessarily teaches maintaining a link. In fact, Robert teaches away from maintaining a linked exchange because step 34 specifically indicates that autonegotiation (which the Examiner equates to the linked exchange as indicated in the above cited portion) is to be restarted. *See, e.g., Figure 2 of Robert.* It is respectfully submitted that restarting the autonegotiation directly counters the claimed combination of features set forth in claim 1, e.g., including "wherein the transmitting occurs while maintaining a linked exchange between the local and linked network devices."

Moreover, the latter argument was also provided in the Appeal Brief and Examiner's failure to distinguish the difference between a "link partner" and maintaining a link clearly indicates the lack of support for such a rejection.

Accordingly, it is respectfully submitted that claim 1 is in condition for allowance.

**Claims 14, 21, 23, and 48:**

All remaining independent claims 14, 21, 23, and 48 have been rejected for similar reasons as claim 1, and these claims which recite similar (though not identical) language should be allowable for at least similar reasons as claim 1.

These same issues were raised through a pre-appeal conference request filed on December 26, 2007, to avoid the need for an appeal; however, that panel summarily dismissed the request, indicating that Applicant should proceed to the Board.

**Dependent Claims:**

All pending dependent claims including claims 2, 4-12, 15-19, 22, 24, 26-34, 36, 38-39, 41-42, 44-45, 47, 49-51 should be allowable for at least similar reasons as their respective independent claims, as well as additional or alternative elements that are recited therein but not shown in the cited prior art.

Moreover, the Examiner admits in the final Office Action, pages 12-13, that Robert fails to teach the recitation of claims 3, 13, 20, 25, 35, 37, 40, 43, 46, and 52, and relying on Murase in addition to Robert. However, even if Robert and Murase were to be combined, the combination still fails to teach the claimed combination of features such as set forth in claims 3, 13, 20, 25, 35, 37, 40, 43, 46, and 52, in part, because the Examiner has failed the third prong identified by MPEP §2143, which requires that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See, e.g., the discussion of the rejections above or in the Appeal Brief filed June 30, 2008.

Hence, the rejections under 35 U.S.C. §103 are unsupported.

Also, under Argument 4 on pages 14-15 of the Answer, the Examiner states:

In response to argument 4, the Examiner notes paragraph [0017] of Robert, which states that the workstation is “configured for sending and receiving data packets according to IEEE 802.3” ([0017], lines 1-6). Clearly, the communications between devices in the network utilize IEEE 802.3 data packets.

Additionally, the physical layer itself also makes use of data packets. Robert states the “physical layer receiver 16 [is] configured for translating digital packet data” ([0017], lines 7-8).

So clearly, the autonegotiation and renegotiation steps (as discussed in the preceding responses to arguments) between linked network devices in the IEEE 802.3 network utilize digital packet data in the disclosed embodiment of Robert’s teachings.

However, the Examiner still fails to show how sending and receiving packets anticipates the claimed inclusion of “the speed change request and the new transmission speed in a data packet” and the transmission occurring “at the current transmission speed.”

Accordingly, the Examiner has clearly failed to establish that the claimed combination of features set forth under claim 2 is anticipated.



### **CONCLUSIONS**

The Examiner's Answer fails to provide an evidentiary record sufficient to support the required *prima-facie* case of anticipation under 35 U.S.C. §102(e) or obviousness under 35 U.S.C. §103(a). Therefore, Appellant urges the Board to reverse the examiner's rejections of the pending claims.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-4238.

Respectfully submitted,

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Date: October 27, 2008

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